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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/544,776

04/07/2000

Dong Wei

59516-219/PP-01561.003

9574

27476

7590

05/01/2006

EXAMINER

ZARA, JANE J

Chiron Corporation

Intellectual Property - R440

P.O. Box 8097

Emeryville, CA 94662-8097

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/544,776	WEI ET AL.	
	Examiner	Art Unit	
	Jane Zara	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,23-25,28,29 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☒ Claim(s) 1,5-10,28,29,37 is/are rejected.
- 7) ☒ Claim(s) 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the communication filed 2-15-06.

Claims 1, 2, 5-10, 23-25, 28, 29 and 37 are pending in the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments and Amendments

Withdrawn Rejections

Any rejections not repeated in this Office action are hereby withdrawn.

Maintained Rejections/ Rejections Necessitated by Amendment

Claims 1, 5-10, 28, 29 and 37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record set forth in the Office action mailed 8-15-05.

Applicant's arguments filed 2-15-06 have been fully considered but they are not persuasive. Applicants argue that the written description requirements have been met upon amendment of the pending claims and that one of skill in the art can readily identify the genus comprising the breadth of conservative substitutions now claimed. Contrary to Applicant's assertions, the claimed genus still embraces a myriad of sequences that have not been adequately described in the art or in the instant

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disclosure. The disclosure of a single polypeptide sequence, along with the general description of an ER retention motif and purported membrane spanning sequences flanked by charged residues, in the absence of well developed prior art, mutational analysis or other structure function relationships distinguishing this novel polypeptide from other endoplasmic reticulum polypeptides, do not fulfill the requirements for adequate written description for the genus claimed.

The structure function information provided in the prior art and in the instant disclosure is of a general nature because it describes common attributes of endoplasmic reticular or intramembraneous proteins. The presence of such common elements does not address the question of what structures are required for the genus comprising homologues of Nogo B comprising conservative amino acid substitutions, or comprising oligonucleotides unique to Nogo B cDNA without recitation of the appropriate polynucleotide sequence. The specification and claims do not adequately describe the polynucleotides between 8 and 50 nucleobases in length that are unique to Nogo B cDNA, whereby their administration inhibits cell growth in vitro, as recited in claim 28 and as embraced by claim 29.

Claim Objections

Claims 23-25 are objected to because of the following informalities: In claim 23, line 3, the text –polynucleotide—appears to be missing after “said” and before “between”. Appropriate correction is required.

Allowable Subject Matter

Claims 2 and 23-25 appear free of the prior art searched and of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

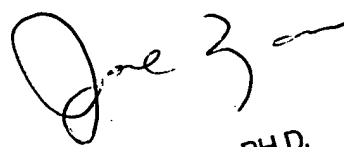
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(571) 272-0765**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (571) 272-0564. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jane Zara
4-28-06

 TC 1600
JANE ZARA, PH.D.
PRIMARY EXAMINER